



UNITED STATES PATENT AND TRADEMARK OFFICE

Uer

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,631	09/30/2003	Kenneth D. Nelson	T-6133 (538-56)	6068

7590 01/02/2008
Michael E. Carmen, Esq.
M. CARMEN & ASSOCIATES, PLLC
Suite 400
170 Old Country Road
Mineola, NY 11501

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
----------	--------------

1796

MAIL DATE	DELIVERY MODE
-----------	---------------

01/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/675,631

Applicant(s)

NELSON ET AL.

Examiner

Patrick D. Niland

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 63-75 is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Art Unit: 1796

1. The amendment of 4/9/07 has been entered. Claims 1-75 are pending.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11, 14-23, 26-37, 39-40, 42-45, 49-51, and 54-62 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 3140997 Price.

Price discloses compositions falling within the scope of “stable colloidal suspensions” having the instantly claimed components at column 1, lines 9-15 and 55-63, which acidic aqueous media is expected to form the instantly claimed polymolybdates with the claimed molybdenum compounds and to hydrate said polymolybdates, column 2, lines 1-72, particularly 1-5, 19-27, which encompasses the instant claims 3-5, lines 28-47, 55-71, which shows the dispersed molybdate to be hydrated, column 3, lines 27-65 and column 4, lines 15-16, which encompasses the instantly claimed detergents of claims 14-17, column 4, lines 15-24 which shows the dispersant phase to contain the instantly claimed diluent oil, and the remainder of the document. Hydrated polymolybdate will be within the amounts of the instant claims 7-8 since the ketones of the patentee are expected to be soluble in the dispersant phase and therefore not part of the “dispersed phase”. “Colloidal” of the patentee and the similarities in processing indicate that the

Art Unit: 1796

particle sizes and turbidity and clarity of the patentee's dispersions are those of the instant claims 9-11. The methodology of the patentee falls within the scope of the instant claims 18 and 43 and claims 19-23, 26-34, 44-45, 49-51, and 54-62, which depend from claims 18 and 43. The patentee adds their dispersion to lubricating oil to give a composition falling within the scope of that of the instant claims 35-37, 39-40, with claims 40 and 42 being met by the amounts of ketone prior to removal of the ketone.

The applicant argues that the patentee does not disclose the instantly claimed invention as argued at page 15, lines 5-12 of their arguments. The applicant has not shown the colloidal dispersions of the patentee to not possess the instantly claimed clarity nor that the polymolybdenates of the patentee are not the major phase of the resulting colloid disperse phase nor that the dispersions are not stable. As stated above, it appears that the components and processing are the same as those of the instant claims and would have been expected to yield the instantly claimed clear dispersion, as indicated by "colloid". The applicant provides no probative evidence to the contrary. See MPEP 2112-2113. The applicant argues regarding "Molbdenum: The Element and Aqueous Solution Chemistry, Vol. 36.1, pp. 1256-1264. However, this reference is not seen. There is therefore no probative evidence that the molybdenate is not polymeric. Furthermore, it is not seen that the dimer is not polymeric either. The applicant argues that Example 4 of their specification shows that Example 2 of Price would be hazy. This is not commensurate in scope with the full disclosure of Price nor example 2 of the patentee. It is therefore not seen that the processes of the patentee do not make the instantly claimed clear dispersions as indicated by "colloidal" of the patentee. It is further not seen via probative evidence that the method of example 2 of the patentee that gives a colloidal dispersion

Art Unit: 1796

does remove too much water, according to the instant invention, does not contain polymeric molybdenate, and is not clear. The reference resubmitted, "Molybdenum Compounds", Vol. 16, page 941, states that below pH of 7 the polymeric forms of the molybdenates exist. There is no probative evidence to the contrary as the examiner does not see the reference argued, as discussed above. This rejection is therefore maintained.

5. Claims 1-11, 14-23, 26-37, 39-40, 42-45, 48-51, and 54-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 3140997 Price.

Price discloses compositions falling within the scope of "stable colloidal suspensions" having the instantly claimed components at column 1, lines 9-15 and 55-63, which acidic aqueous media is expected to form the instantly claimed polymolybdates with the claimed molybdenum compounds and to hydrate said polymolybdates, column 2, lines 1-72, particularly 1-5, 19-27, which encompasses the instant claims 3-5, lines 28-47, 55-71, which shows the dispersed molybdate to be hydrated, column 3, lines 27-65 and column 4, lines 15-16, which encompasses the instantly claimed detergents of claims 14-17, column 4, lines 15-24 which shows the dispersant phase to contain the instantly claimed diluent oil, and the remainder of the document. Hydrated polymolybdate will be within the amounts of the instant claims 7-8 since the ketones of the patentee are expected to be soluble in the dispersant phase and therefore not part of the "dispersed phase". "Colloidal" of the patentee and the similarities in processing indicate that the particle sizes and turbidity and clarity of the patentee's dispersions are those of the instant claims 9-11. The methodology of the patentee falls within the scope of the instant claims 18 and 43 and claims 19-23, 26-34, 44-45, 49-51, and 54-62, which depend from claims 18 and 43. The patentee adds their dispersion to lubricating oil to give a composition falling within the scope of

Art Unit: 1796

that of the instant claims 35-37, 39-40, with claims 40 and 42 being met by the amounts of ketone prior to removal of the ketone.

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed combinations of ingredients and amounts thereof and the methods of making the instantly claimed compositions because they are encompassed by the patentee and would have been expected to give the benefits disclosed by the patentee. It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the acids of claim 48 because they are encompassed by "mineral acids" of column 2, lines 32-35 and would not give the chlorine content not desired by the patentee at column 2, lines 37-42.

The applicant argues that the patentee does not disclose the instantly claimed invention as argued at page 15, lines 5-12 of their arguments. The applicant has not shown the colloidal dispersions of the patentee to not possess the instantly claimed clarity nor that the polymolybdenates of the patentee are not the major phase of the resulting colloid disperse phase nor that the dispersions are not stable. As stated above, it appears that the components and processing are the same as those of the instant claims and would have been expected to yield the instantly claimed clear dispersion, as indicated by "colloid". The applicant provides no probative evidence to the contrary. See MPEP 2112-2113. The applicant argues regarding "Molybdenum: The Element and Aqueous Solution Chemistry, Vol. 36.1, pp. 1256-1264. However, this reference is not seen. There is therefore no probative evidence that the molybdenate is not polymeric. Furthermore, it is not seen that the dimer is not polymeric either. The applicant argues that Example 4 of their specification shows that Example 2 of Price would

Art Unit: 1796

be hazy. This is not commensurate in scope with the full disclosure of Price nor example 2 of the patentee. It is therefore not seen that the processes of the patentee do not make the instantly claimed clear dispersions as indicated by "colloidal" of the patentee. It is further not seen via probative evidence that the method of example 2 of the patentee that gives a colloidal dispersion does remove too much water, according to the instant invention, does not contain polymeric molybdenate, and is not clear. The reference resubmitted, "Molybdenum Compounds", Vol. 16, page 941, states that below pH of 7 the polymeric forms of the molybdenates exist. There is no probative evidence to the contrary as the examiner does not see the reference argued, as discussed above. This rejection is therefore maintained.

6. Claims 1-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 3140997 Price in view of US Pat. No. 4601837 Valcho et al..

Price discloses compositions falling within the scope of "stable colloidal suspensions" having the instantly claimed components at column 1, lines 9-15 and 55-63, which acidic aqueous media is expected to form the instantly claimed polymolybdates with the claimed molybdenum compounds and to hydrate said polymolybdates, column 2, lines 1-72, particularly 1-5, 19-27, which encompasses the instant claims 3-5, lines 28-47, 55-71, which shows the dispersed molybdate to be hydrated, column 3, lines 27-65 and column 4, lines 15-16, which encompasses the instantly claimed detergents of claims 14-17, column 4, lines 15-24 which shows the dispersant phase to contain the instantly claimed diluent oil, and the remainder of the document. Hydrated polymolybdate will be within the amounts of the instant claims 7-8 since the ketones of the patentee are expected to be soluble in the dispersant phase and therefore not part of the "dispersed phase". "Colloidal" of the patentee and the similarities in processing indicate that the

Art Unit: 1796

particle sizes and turbidity and clarity of the patentee's dispersions are those of the instant claims 9-11. The methodology of the patentee falls within the scope of the instant claims 18 and 43 and claims 19-23, 26-34, 44-45, 49-51, and 54-62, which depend from claims 18 and 43. The patentee adds their dispersion to lubricating oil to give a composition falling within the scope of that of the instant claims 35-37, 39-40, with claims 40 and 42 being met by the amounts of ketone prior to removal of the ketone.

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed combinations of ingredients and amounts thereof and the methods of making the instantly claimed compositions because they are encompassed by the patentee and would have been expected to give the benefits disclosed by the patentee. It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the acids of claim 48 because they are encompassed by "mineral acids" of column 2, lines 32-35 and would not give the chlorine content not desired by the patentee at column 2, lines 37-42. It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed polyalkylene succinic anhydrides as the dispersants of Price because Valcho et al. shows such dispersants to improve the efficiency of molybdenum incorporation into similar dispersions and to improve product clarity at column 2, lines 31-37 and these improvements would have been expected in the compositions of Price.

The applicant argues that the patentee does not disclose the instantly claimed invention as argued at page 15, lines 5-12 of their arguments. The applicant has not shown the colloidal dispersions of the patentee to not possess the instantly claimed clarity nor that the polymolybdenates of the patentee are not the major phase of the resulting colloid disperse phase

Art Unit: 1796

nor that the dispersions are not stable. As stated above, it appears that the components and processing are the same as those of the instant claims and would have been expected to yield the instantly claimed clear dispersion, as indicated by "colloid". The applicant provides no probative evidence to the contrary. See MPEP 2112-2113. The applicant argues regarding "Molbdenum: The Element and Aqueous Solution Chemistry, Vol. 36.1, pp. 1256-1264. However, this reference is not seen. There is therefore no probative evidence that the molybdenate is not polymeric. Furthermore, it is not seen that the dimer is not polymeric either. The applicant argues that Example 4 of their specification shows that Example 2 of Price would be hazy. This is not commensurate in scope with the full disclosure of Price nor example 2 of the patentee. It is therefore not seen that the processes of the patentee do not make the instantly claimed clear dispersions as indicated by "colloidal" of the patentee. It is further not seen via probative evidence that the method of example 2 of the patentee that gives a colloidal dispersion does remove too much water, according to the instant invention, does not contain polymeric molybdenate, and is not clear. The reference resubmitted, "Molybdenum Compounds", Vol. 16, page 941, states that below pH of 7 the polymeric forms of the molydenates exist. There is no probative evidence to the contrary as the examiner does not see the reference argued, as discussed above. This rejection is therefore maintained.

7. Claims 63-75 are allowable over the prior art considered.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**


Art Unit: 1796

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrick D. Niland
Primary Examiner
Art Unit 1714